

REMARKS

Claims 1-20 are currently pending. Reconsideration and allowance of the pending claims are respectfully requested in light of the foregoing amendments and following remarks.

Rejections under 35 U.S.C. §103

Claims 1-3, 5, 8-10, 12, and 15-18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0027569 to Ejzak (hereinafter “Ejzak”) in view of U.S. Patent No. 6,738,615 to Chow et al. (hereinafter “Chow”), further in view of U.S. Patent Application Publication No. 2005/0078812 to Batni et al. (hereinafter “Batni”), and further in view of U.S. Patent Application Publication No. 2003/0041242 to Patel (hereinafter “Patel”). Claims 4, 6, 7, 11, 13, 14, 19, and 20 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ejzak in view of Chow further in view of Batni further in view of Patel, and further in view of U.S. Patent Application Publication No. 2002/0167946 to Gallant (hereinafter “Gallant”).

In response, Applicants respectfully traverse the rejection of the pending claims on the grounds that the cited combination of references is defective in establishing a prima facie case of obviousness with respect to the claims.

As the PTO recognizes in MPEP § 2142:

The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness. . . .

It is submitted that in the present case, the Examiner has not factually supported a prima facie case of obviousness with regard to the subject claims for at least the following reasons.

Independent claim 1 recites, *inter alia*:

receiving a circuit-switched call origination message in a home mobile station domain, wherein the circuit-switched call origination message specifies a destination terminal device having a directory number assigned with the home mobile station domain;

(emphasis added).

Applicants once again respectfully traverse the Examiner’s position that paragraphs [0034] through [0046] and paragraph [0064] of Ejzak teach this element and submit that a careful reading of the cited text reveals it to be completely devoid of any teaching of a “call origination message [that specifies] a destination terminal device having a directory number assigned with the home mobile station domain,” as clearly required by claim 1. The deficiencies of Ejzak in this regard are not remedied by Chow, which is cited by the Examiner as teaching, at column 68, lines 50-64:

receiving, by the home mobile station domain from the servicing mobile station domain, a first message that requests the home mobile station domain to provide a call progress signal to the calling party prior to establishment of a bearer path between the serving mobile station domain and a telephone network of the calling party; and providing, by the home mobile station domain, a first call progress signal to the calling party.

As with Ejzak above, a careful reading of the Chow passage reveals that the reference fails to teach the subject element. In particular, while the cited portion of Chow does reference generating a ring-back tone toward the calling party, it fails to teach receiving from a servicing mobile station a request that the home mobile station generate such a signal prior to the establishment of a bearer path between the serving mobile station and the telephone network of the calling party, as clearly required by claim 1. The Examiner appears to have at least partially conceded to Applicants' position in this regard and in the present Office action cites Batni as providing "clarification" on this point.

With regard to Batni, the Examiner cites paragraph [0037] thereof as disclosing the above-noted element. In particular, the Examiner indicates that the IP 124 provides a first call progress signal to the calling party. Applicants respectfully traverse the Examiner's position in this regard and submit that the IP 124 is not described by Batni as comprising a component of the home mobile station domain, as clearly recited in claim 1.

Patel, which is cited by the Examiner as teaching that the message received by the home mobile station domain originates from the serving mobile station domain, fails to remedy the deficiencies of the cited combination in this regard.

In view of the foregoing, it is apparent that the subject rejection of claim 1 is not supported by the cited combination and should be withdrawn. Independent claims 8 and 15 include limitations similar to those of claim 1 and are therefore also deemed to be in condition for allowance for the reasons set forth above. Claims 2-7, 9-14, and 16-20 depend from and further limit independent claims 1, 8, and 15, and are therefore also allowable for at least that reason.

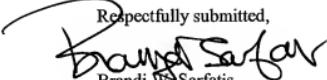
Thus, for at least this additional reason, the Examiner's burden of factually supporting a *prima facie* case of obviousness with respect to claims 1-20 has clearly not been met, and the rejection thereof under 35 U.S.C. §103 should be withdrawn.

Conclusion

It is clear from the foregoing that all of the pending claims are in condition for allowance and prompt notification to that effect is respectfully requested.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,


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I hereby certify that this correspondence is being transmitted via EFS-Web to the United States Patent and Trademark Office, on the date indicated below.

Date: December 22, 2010


Ellen Lovelace